REMARKS/ARGUMENTS

In response to the Office Action dated April 12, 2006, Applicants respectfully request the Office to enter the above amendments and consider the following remarks. By this amendment, claims 23, 26, 30, and 32 have been amended and claims 24, 25, 31, and 32 have been cancelled. Applicants also have added new claims 37 and 38 and submit that these new claims are fully supported by the specification and introduce no new subject matter.. After entry of this paper, claims 23, 26–30, and 33–38 will remain pending in this application.

In the Office Action, the Examiner rejected claims 23–36 under 35 U.S.C. § 102(e) as allegedly being unpatentable over U.S. Patent Application Publication No. US 2002/0120680 A1 to Greco et al. ("Greco").

Rejections Under 35 U.S.C. § 102

Claims 23–36 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Greco. Applicants respectfully disagree, and traverse this rejection for at least the following reasons.

Applicants respectfully submit that Greco does not teach or suggest, *inter alia*, a computer-implemented method for electronically signing an electronic document comprising "receiving an indication from the user as to which data elements, if any, of the document the user wishes to electronically sign" as recited in claim 23, as amended, of the present application.

Greco teaches systems and methods that include basic "electronic signature of the relevant document(s) by the user." (Greco, paragraphs 0031-0032). In the Office Action, the Examiner equates "receiving an indication from the user as to whether the user wishes to electronically sign all or part of the electronic document," as recited by claim 1, with "the use of a document preparation application and associated GUI to select document objects (i.e., text, images, audio files, etc., . . .)" for electronic signature. Office Action, p. 3. In Greco, however, the "objects" and their functions as disclosed in Greco teach "configuring a plurality of graphical selectable objects based on the available document services, each of the graphical selectable objects corresponding to one of the available document services . . ." [paragraph 0012]. Greco further discloses implementing these selectable objects in a toolbar [paragraph 15], wherein each object may be a "software button[] that implement[s] certain document-related services . . ." [paragraph 0062]. Examples given of such buttons (and corresponding document services) include:

> E-Signature Service button 405, an Overnight Courier Service button 410, an E-Mail Service button 415, a Data Storage Service button 420, a Traditional Mail Service button 425, a Translation Service button 430, a Print and Copy Room Service button 435, a Government Filing Service button 440, a By Hand Delivery Service button 445, an Address Book Management Service button 450, an E-Collaboration Service button 455." [paragraph 0045].

However, Greco does not teach or suggest, *inter alia*, selecting *within* a document. The objects disclosed in Greco are not text, images, audio files, or other data elements within a document, as the Examiner suggests, but rather are graphical objects such as buttons that may be selected by a user to indicate which of a plurality of document services the user wishes to use. Greco does not teach differentiating between data elements based on whether they do or do not need to be signed.

Greco's systems and methods are unable to perform, *inter alia*, any sort of processing for the purpose of signing only some parts or data elements of the document that may require a signature, as is inherent in the steps of claim 23, as amended. Greco and, specifically, the cited portions of Greco, fail to teach or suggest such functionality, as are reflected, for example, in Fig. 6 and paragraphs 0004, 0029, and 0041 of the present application. Consequently, Greco does not teach or suggest a computer-implemented method for electronically signing an electronic document comprising "receiving an indication from the user as to which data elements, if any, of the document the user wishes to electronically sign" as recited in claim 23.

Further, Greco does not teach or suggest the feature "signing the indicated data elements, if any, of the electronic document . . ." as recited in claim 23, as amended. As discussed above, neither Greco as a whole, nor the portions of Greco cited by the Examiner, teach differentiating between data elements based on whether they do or do not need to be signed. Because the determination of whether a signature is required occurs only at the document level in Greco, it is impossible for the invention of Greco to practice signing only part of an electronic document. Therefore, Greco does not

disclose a computer-implemented method for electronically signing an electronic document comprising "signing the indicated data elements, if any, of the electronic document . . ." as recited in claim 23, as amended, of the present application.

Further, Greco does not teach or suggest, *inter alia*, the feature "if the user wishes to sign all or part of the electronic document, determining which of a plurality of electronic signatures is to be used based on user information or the identity of an intended recipient" as recited in amended claim 23. Greco teaches an "E-Signature Service button [that] may initiate an electronic or digital signature function to permit a user to officially sign a document . . . ." [Greco, paragraph 0063]. However, Greco does not teach or disclose any functionality that would allow the user of the system to select the appropriate signing service to use from a plurality of available signing services. Greco discloses the use of a single pre-defined "electronic or digital signature function." [Greco, paragraph 0063] but does not describe any details of the function of such a signature function. In fact, the only description in Greco of an implementation of a signing service describes the use of a physical (rather than electronic) service provider for authenticating signatures, wherein the user may communicate with, provide physical or digital signatures to, or receive a signature in electronic form from the service provider via fax or email. [Greco, paragraph 0063].

In contrast, the present application teaches selecting from a plurality of available electronic signing services. [paragraphs 0024, 0030, 0036, and 0043; Fig. 6, step 370]. Signing services may be associated with particular users, recipients, or other system services on a global or document-by-document basis. [paragraphs 0030, 0056, and

0043; Fig. 6, step 370]. Because Greco does not teach or suggest any such functionality for selecting among a plurality of signing services based on user information or the identity of an intended recipient, Greco does not teach or suggest a computer-implemented method for electronically signing an electronic document comprising "if the user wishes to sign all or part of the electronic document, determining which of a plurality of electronic signatures is to be used based on user information or the identity of an intended recipient" as recited in claim 23.

For at least these reasons, Applicants request that the rejection of claim 23, as amended, under 35 U.S.C. 102(e) be withdrawn and the claim allowed. Claims 26–29 and 37 depend from claim 23 and are therefore also allowable over Greco for at least the same reasons as claim 23.

Additionally, claim 30, as amended, is an apparatus claim embodying similar functionality as discussed above with reference to claim 23. The same portions of Greco have been cited against the recitations of claim 30 as were cited against claim 23. However, as set forth above, Greco and especially the cited portions of Greco, fail to teach or suggest anything more than a broad "electronic signature function." Greco does not distinguish between *data element* types, *e.g.*, based on signature requirements. Thus, Greco can not teach "receiving an indication from the user as to which data elements, if any, of the document the user wishes to electronically sign," "signing the indicated data elements, if any, of the electronic document . . .," or "if the user wishes to sign all or part of the electronic document, means for determining which of a plurality of electronic signature services is to be used based on user data or the

identity of an intended recipient" as recited in amended claim 30. Thus, Applicants submit that claim 30, as amended, is distinguishable over Greco for at least the same reasons stated above with respect to claim 23.

For at least these reasons, Applicants request that the rejection of claim 30, as amended, under 35 U.S.C. 102(e) be withdrawn and the claim allowed. Claims 33–36 and 38 depend from claim 30 and are thus also allowable over Greco for at least the same reasons as claim 30.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all claims are now in condition for allowance and request reconsideration and reexamination of this application and the timely allowance of all pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: July 11, 2006

By: _____
C. Larry O'Rourke
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